

REMARKS

In the Action mailed April 17, 2007, the Examiner issued new rejections of all pending claims 1-25, and made the Action final. Applicants above have amended claims 1, 4, 14, 18 and 21, have canceled claims 3, 5-6, 19 and 20, and have added new claims 41-49. In addition, Applicants have canceled previously withdrawn claims 26-40. As such, claims 1-2, 4, 7-18, 21-25 and 41-49 are pending. Applicants submit that the amendments are made to bring the case in condition for allowance.

Applicants respectfully request that the finality of the rejections be withdrawn, that the amendments be entered, and that a notice of allowance be issued. In addition, applicants note that it appears the first Information Disclosure Statement (IDS) filed March 25, 2004, has been overlooked, and request that the Examiner consider the references cited in this IDS (courtesy copy attached).

Claim Amendments and Added Claims 41-49

Independent claim 1 has been amended above to address the Section 112 rejections (as discussed below), and further to incorporate the limitations of claim 3 into claim 1. Applicants note that claim 1 was not subjected to any prior art rejections.

Independent claim 18 has been amended above to address the Section 112 rejections (as discussed below), and further to incorporate the limitations of claim 19 into claim 18. Applicants note that claim 19 was not subjected to any prior art rejections.

Independent claim 41 is directed to subject matter previously set forth in claim 5, now canceled, with further amendment to address the Section 112 rejections (as discussed below). Applicants note that claim 5 was not subjected to any prior art rejections. Dependent claims 42-49 depend from claim 41 and are directed to subject matter previously set forth in claims 2, 4, 7, 8, 9, 10, 12 and 13.

The amendments and added claims add no new matter.

Accordingly, Applicant's submit that claims 1, 18 and 41-49 are in condition for allowance.

Claim Rejections -- 35 USC 112

Claims 1-25 stand rejected under 35 U.S.C. 112, first paragraph, because allegedly the specification, while being enabling for determining the normal body temperature of a human, does not reasonably provide enablement for determining the normal body temperature of a body. While Applicants do not agree, to advance prosecution on the merits Applicants have limited all currently pending claims to the human body.

Accordingly, Applicants respectfully request that the Examiner withdraw the Section 112, first paragraph, claim rejections.

Claims 1-25 also stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. In particular, the Examiner contends it is impossible to determine the metes and bounds of the claims because 'normal body temperature' is an indefinite term, which the Examiner contended could be any temperature. Again, while Applicants do not agree, to advance prosecution on the merits Applicants have specified in each of the pending independent claims normal body temperature of about 37 degrees Celsius.

Accordingly, Applicants respectfully request that the Examiner withdraw the Section 112, second paragraph, claim rejections.

Claim Rejections -- 35 USC 102

Claims 1-2, 6-13, 18 and 20-25 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ginsberg (5,989,238). Of these, claims 1 and 18 are independent claims. As discussed above, claims 1 and 18 have been amended to incorporate the limitations that were previously set forth in, respectively, dependent claims 3 and 19. Applicants submit that claims 1 and 18, as amended, are each directed to subject matter that defines subject matter that is patentable over Ginsberg. Indeed, previously pending dependent claims 3 and 19 were not subjected to any rejections based on prior art.

Accordingly, Applicants respectfully request that the rejections of claims 1-2, 7-13 and 18 based on Ginsberg be withdrawn.

Claims 1-2 and 6-13 stand rejected under 35 U.S.C. 102(e) as being anticipated by Dae et al. (6,607,517). As discussed above, claim 1 has been amended to incorporate the limitations that were previously set forth in dependent claim 3. Applicants submit that claim 1, as amended,

is directed to subject matter that is patentable over Dae et al. Indeed, previously pending dependent claim 3 was not subjected to any rejections based on prior art.

Accordingly, Applicants respectfully request that the rejections of claims 1-2 and 7-13 based on Dae et al. be withdrawn.

Claim Rejections -- 35 USC 103

Claims 14-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Morley et al. (6,113,584). Applicants respectfully disagree.

Morley relates to lysing a patient's heart tissue causing or involved with arrhythmia. (Abstract.) Morley discloses that a lysing medium, such as ethanol or phenol, is introduced into a lumen 16 in a balloon catheter 10 and is discharged from a distal end of the catheter through port 17 into vessel passageway 30 distal of the balloon. (Col. 4, line 65 to col. 5, line 6.) This is done to terminate the electrical activity permanently in the tissue contact by the lysing medium. (See col. 1, lines 58-61.) Morley discloses that before discharging the lysing medium, the catheter 10 may be used to first discharge iced saline from the distal port 17 to paralyze the tissue distal of the catheter. (Col. 6, lines 18-20.) Morley discloses if this terminates the arrhythmia the physician is reasonably assured that the arrhythmia will be permanently terminated by the delivery of the lysing medium to the same location. (Col. 6, lines 20-24.)

Morley does not disclose or suggest a method that includes, as is recited in claim 14, "preventing normal blood flow to the tissue region again by occluding the body vessel before the temperature of the tissue region returns to normal body temperature," and "providing, while the body vessel is occluded, cooled fluid to the tissue region again to maintain the temperature of the tissue region below normal body temperature of about 37 degrees Celsius." There is no reason for this to be done in the techniques described in Morley. Indeed, in Morley it is not being attempted to maintain tissue below normal body temperature for an amount of time. The introduction of iced saline is done only to find out whether that has any immediate effect an arrhythmia. If it does, then presumably the introduction of the iced saline is not performed again. Rather, the lysing medium would then be introduced. If the introduction of the iced saline does not have any immediate effect on the arrhythmia, then presumably the catheter would be moved so that port 17 is directed to another tissue area. Even if it were that iced saline would be introduced again out of the port, this would presumably be done in a different tissue region,

and thus would not meet the last element of claim 14 of "providing, while the body vessel is occluded, cooled fluid to the tissue region again to maintain the temperature of the tissue region below normal body temperature of 37 degrees Celsius."

Therefore, independent claim 14 defines subject matter that is patentable over Morley, as do dependent claims 15-17. Accordingly, Applicants respectfully request that the rejection of claims 14-17 based on Morley be withdrawn.

Conclusion

Applicants respectfully note that an initialed copy of the PTO-1449 form filed March 25, 2004 has not been returned. Thus, Applicants respectfully request return of an initialed copy. For the Examiner's convenience, a copy of the PTO-1449 form filed March 25, 2004, is attached hereto. In addition, copies of the listed references can be resubmitted upon request.

Applicants respectfully submit that claims 1-2, 4, 7-18, 21-25 and 41-49 are in condition for allowance, and ask that the Examiner issue a notice of allowance.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

No fee is believed due for this amendment. Please apply any other charges or credits to deposit account 06-1050.

Applicant : Martin Willard et al.
Serial No. : 10/715,636
Filed : November 18, 2003
Page : 12 of 12

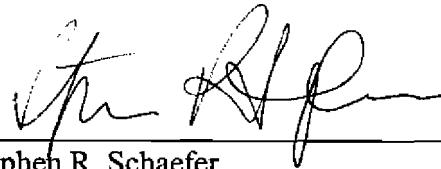
Attorney's Docket No.: 10527-522001 / 03-257

Date: June 25, 2007

Fish & Richardson P.C.
60 South Sixth Street, Suite 3300
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile: (612) 288-9696

60435836.doc

Respectfully submitted,



Stephen R. Schaefer
Reg. No. 37,927